



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,828	10/12/2000	James Paschal McCloskey	MSX 302RI	9910

7590

12/06/2006

Kolisch Hartwell Dickinson McCormack & Heuser  
520 S W Yamhill Street  
Suite 200  
Portland, OR 97204

EXAMINER
----------

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
----------	--------------

3653

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/687,828

Applicant(s)

MCCLOSKEY, JAMES PASCHAL

Examiner

Joseph C. Rodriguez

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-22,25,32,45,52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-22,25,32,45,52 and 53 is/are rejected.
- 7) ☒ Claim(s) 5-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

***Final Rejection***

Applicant's arguments filed 8/03/06 have been fully considered but they are not persuasive for reasons detailed below.

The 35 U.S.C. 112 rejections are maintained or modified as follows:

These rejections have been withdrawn in view of Applicant's amendments.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 45 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Re-Tech Eliminator ("Re-Tech")(see Exhibits A-E listed on Non-Patent Literature p. 2 of 3 in IDS, IFW date 4/25/05 and Appendix A, describing Figures 1-13 that contain specifications and color photos of Eliminator, also listed as Non-Patent Literature p. 2 of 3 in IDS, IFW date 4/25/05).

Re-tech teaches a trommel vehicle (best shown in fig. 12, 13 of Appendix A) comprising:

a chassis (see vehicle structure mounted over wheels) supported for travel over a ground surface;

an input hopper with a conveyor means (Fig. 13, see top photo and Specifications teaching "direct in-feed conveyors");

an elongate trommel (Fig. 13, drum) mounted on the chassis having an input (vehicle front) and output ends (vehicle rear);

an output means mounted below the trommel (Fig. 13, see diagram below photos wherein collection and discharge chutes for respective conveyors are inherent);

a deployable elongate conveyor, or rejected material conveyor, having first and second elongate components where the first component is mounted on the chassis adjacent the output end of the trommel and is movable relative to the chassis about angularly displaced first and second axes and where the second component articulates with the first component about a third axis that is generally parallel to the second axis as the conveyor moves between a deployed and stowed condition (Fig. 12, 13, showing deployed and stowed conditions of double fold out reject conveyor at trommel output end as well as hydraulic actuating means and mechanical linkages for the folding conveyors); and

a stockpiling conveyor mounted on the other end of the chassis (Fig. 12, 13, showing deployed and stowed conditions of double fold out stockpiling conveyor near trommel input end as well as actuating, support means and mechanical linkages), wherein the rejected material conveyor and the stockpiling conveyor extend upwardly and outwardly during operation and do not extend substantially outwardly in their retracted positions (Id.). With regards to claim 45, it is noted that the axes can be drawn virtually anywhere in relation to the conveyor as Applicant has not specified a relative

Art Unit: 3653

plane (i.e., horizontal or vertical) for the axes, thus the conveyor can be regarded as articulating or moving about these axes as claimed. Further, a power source and control means for the hydraulic actuating means taught can be regarded as inherent. With regards to claim 53, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the conveyor cited above is certainly capable of being "movable" as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7-22, 32 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Re-Tech in view of Pettijohn (US 5,193,971) and Cedar Rapids ("Cedar")(see Exhibits N, O, P1-P3 listed on Non-Patent Literature p. 2 of 3 in IDS, IFW date 4/25/05).

Re-Tech as set forth above teaches all that is claimed except for expressly teaching the stockpiling conveyor with the first lower part mounted to a turntable that is mounted to the chassis for rotation about a vertical axis, wherein said conveyor includes driven means and hydraulic actuating means. Pettijohn, however, teaches a folding

Art Unit: 3653

conveyor that rotates about a vertical axis (Fig. 6 teaching turntable 58, 94 driving by hydraulic system and actuating means 16, 17). Cedar also teaches a delivery conveyor that rotates about a vertical axis (Exhibit N1, teaching swivel conveyor). Moreover, Cedar teaches that these conveyors have a broader range of movement, thus allowing more flexibility and maneuverability when creating stockpiles (Id. teaching greater clearance). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the conveyors taught by Re-Tech as taught above to allow for greater flexibility and maneuverability when creating stockpiles and delivering material.

### ***Response to Arguments***

Applicant's arguments that the prior art fails to teach the claimed features are unpersuasive. With regards to claim 25, Applicant's contention that the prior art fails to teach a "stockpiling conveyor mounted on the other end" is undermined by a review of the prior art. Here, Applicant is reminded that claim language is interpreted as broadly as reason allows and it is not unreasonable to interpret a conveyor oppositely located from a first conveyor as at the other end. With regards to claim 45, Applicant's contention that claim 45 clearly defines 3 distinct is not supported by a review of the claim language. Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02; 2114. Here, the conveyor cited above is

Art Unit: 3653

certainly capable of being "moveable" as claimed. Applicant is encouraged to distinguish the alleged invention from the prior art with actual structural features. The mere use of axes defined "generally vertically or horizontally" to describe functional parameters and the continued emphasis on these features in Applicant's arguments is wholly unpersuasive. Consequently, the claims stand rejected.

Applicant's arguments that the prior art combination is merely hindsight reconstruction, lack proper motivation and involve non-analogous art are similarly unconvincing. The motivation was clearly recited in the prior art rejection repeated above, thus it is unclear on what basis Applicant is making this contention. In response to applicant's argument that Pettijohn and Cedar Rapids is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Here, Applicant has attempted to narrowly define his field of endeavor to trommels, but then emphasize conveyor features in his arguments. Applicant's alleged invention clearly encompasses the conveyor art, thus both Pettijohn and Cedar Rapids are clearly related. Applicant's contention that the prior art combination would be inoperable is also without merit. Applicant is strongly advised to carefully review the prior art. Consequently, as Applicant's arguments are severely undermined by a review of the prior art, the claims stand rejected.

***Allowable Subject Matter***

Claims 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,819,950 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Further, in accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed if Applicant chooses to make further amendments to the application.

That is, an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1), that also encompasses the amendments, that contains a statement that all amendments made since the filing of the reissue were made without any deceptive intention on the



Art Unit: 3653

part of the applicant (see 37 CFR 1.175 and MPEP § 1414) would overcome a rejection under 35 U.S.C. 251.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Art Unit: 3653

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST). The Supervisory Examiner is Patrick Mackey, **571-272-6916**.

The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

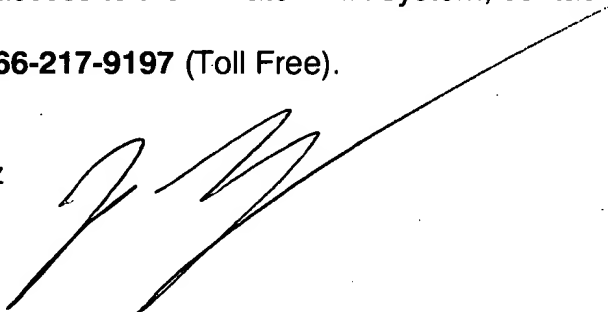
Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Signed by Examiner Joseph Rodriguez

Jcr

\*\*\*

December 3, 2006

A handwritten signature in black ink, appearing to be 'JCR', is written over the signature line and extends diagonally across the bottom right of the page.